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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/524,852

02/18/2005

Ayaka Hamanaga

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3545

513

7590

07/18/2006

WENDEROTH, LIND & PONACK, L.L.P.

2033 K STREET N. W.

SUITE 800

WASHINGTON, DC 20006-1021

EXAMINER

FIGUEROA, MARISOL

ART UNIT

PAPER NUMBER

2617

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/524,852

Applicant(s)

HAMANAGA ET AL.

Examiner

Marisol Figueroa

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Amendment

2. Applicant's amendments were received on 3/01/2006 and 3/20/2006. Applicant amended claims 1, and 5-13, and cancelled claims 2-4. Accordingly, claims 1, and 5-13 are currently pending in the present application.

Response to Arguments

3. Applicant's arguments with respect to claims 1, and 5-13 have been considered but are moot in view of the new ground(s) of rejection.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, this Action is made Final.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claim 12** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 12 is drawn to a "computer data signal embodied in a carrier wave" *per se* as recited in

the preamble and as such is non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. **Claims 1, 5, and 10-13** rejected under 35 U.S.C. 103(a) as being unpatentable over BROWN et al. (US 7,010,288 B2) in view of MAGUIRE et al. (US 2005/0130631 A1).

Regarding claim 1, Brown discloses a mobile terminal having a communication function, the mobile terminal comprising:

a message storing section operable to store a plurality of answering messages (see abstract, lines 6-9; col. 3, lines 34-39, and Fig. 7; i.e., auto response-messages);

a detection section operable to detect an incoming or outgoing phone call (see col. 2, lines 28-32; col. 4, lines 29-33);

an information acquisition section operable to acquire an answering message used in answering an incoming call from the message storing section in response to detection of an incoming call by the detection section (see col. 4, lines 24-54; col. 5, lines 4-21, and Fig. 3);

a history generation section operable to generate history information in which the answering message acquired by the information acquisition section is kept in association with at least a telephone number of the incoming call as a piece of history information; a history storing section operable to store the history information (see col. 4, lines 59-64; col. 5, lines 21-37; i.e., log of calls with associated caller ID);

and a history notification section operable to notify a user of the mobile terminal of the answering message contained in the piece of the history information (see col. 6, lines 28-33).

Brown doesn't expressly disclose the piece of history information is notified to the user in response to an incoming or outgoing call from or to the telephone number contained in the piece of the history information stored in the history storing section.

However, Maguire teaches a method for viewing communications events history on a mobile device associated with the correspondent of an incoming communications event (i.e., incoming

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phone call). After a communications event has been received the communications event is added to the database of the mobile device, then upon the receipt of a communications event (i.e., incoming phone call), the mobile device uses the correspondent identification to retrieve and display a communications event history from the database (see abstract; p.0012, lines 1-24; p.0013; p.0027-0028; p.0030-0031; p.0036).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention, to notify the user with history information in response with an incoming call or outgoing call from or to the telephone number contained in the piece of the history information contained in the history storing section, as suggested by Maguire, in order for the user to determine the context of a communications event to be placed.

Regarding claim 5, the combination of Brown and Maguire discloses the mobile terminal according to claim 1, Brown discloses wherein, the history storing section is further operable to store information indicating whether or not the telephone number contained in the piece of history information has been redialed, and at a time of the incoming or outgoing call, the history notification section is operable to notify the user of the answering message associated with the piece of the history information containing the telephone number only if the telephone number has not yet been redialed (see col. 6, lines 28-33).

Regarding claim 10, Brown discloses an incoming/outgoing history management method for managing a communication history of a mobile terminal, the incoming/outgoing call history management method comprising:

detecting an incoming or outgoing phone call from or to another mobile terminal; (see col. 2, lines 28-32; col. 4, lines 29-33);

acquiring an answering message used in answering an incoming call from a plurality of answering messages in response to the detection of an incoming call; (see abstract, lines 6-9; col. 3, lines 34-39; col. 4, lines 24-54; col. 5, lines 4-21, and Fig. 3);

generating history generation section in which the answering message is kept in association with at least a telephone number of the incoming call as a piece of the history information; storing the generated history information (see col. 5, lines 21-37; i.e., log of calls with associated caller ID);

and notifying a user of the mobile terminal of the answering message contained in the piece of the history information (see col. 6, lines 28-33).

Brown doesn't expressly disclose the piece of history information is notified to the user in response to an incoming or outgoing call from or to the telephone number contained in the piece of the history information stored in the history storing section.

However, Maguire teaches a method for viewing communications events history on a mobile device associated with the correspondent of an incoming communications event (i.e., incoming phone call). After a communications event has been received the communications event is added to the database of the mobile device, then upon the receipt of a communications event (i.e., incoming phone call), the mobile device uses the correspondent identification to retrieve and display a communications event history from the database (see abstract; p.0012, lines 1-24; p.0013; p.0027-0028; p.0030-0031; p.0036).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention, to notify the user with history information in response with an incoming call or outgoing call from or to the telephone number contained in the piece of the history information contained in the history storing section, as suggested by Maguire, in order for the user to determine the context of a communications event to be placed.

Regarding claim 11, Brown discloses a program embodied on a computer readable medium for causing a mobile terminal to perform an incoming/outgoing call history management method for managing a communication history of the mobile terminal, the program causing the mobile terminal to execute (see col. 8, lines 20-36):

- detecting an incoming or outgoing phone call from or to another mobile terminal; (see col. 2, lines 28-32; col. 4, lines 29-33);

- acquiring an answering message used in answering an incoming call from a plurality of answering messages in response to the detection of an incoming call; (see abstract, lines 6-9; col. 3, lines 34-39; col. 4, lines 24-54; col. 5, lines 4-21, and Fig. 3);

- generating history generation section in which the answering message is kept in association with at least a telephone number of the incoming call as a piece of the history information; storing the generated history information (see col. 5, lines 21-37; i.e., log of calls with associated caller ID);

- and notifying a user of the mobile terminal of the answering message contained in the piece of the history information (see col. 6, lines 28-33).

Brown doesn't expressly disclose the piece of history information is notified to the user in response to an incoming or outgoing call from or to the telephone number contained in the piece of the history information stored in the history storing section.

However, Maguire teaches a method for viewing communications events history on a mobile device associated with the correspondent of an incoming communications event (i.e., incoming phone call). After a communications event has been received the communications event is added to the database of the mobile device, then upon the receipt of a communications event (i.e., incoming phone call), the mobile device uses the correspondent identification to retrieve and display a

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communications event history from the database (see abstract; p.0012, lines 1-24; p.0013; p.0027-0028; p.0030-0031; p.0036).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention, to notify the user with history information in response with an incoming call or outgoing call from or to the telephone number contained in the piece of the history information contained in the history storing section, as suggested by Maguire, in order for the user to determine the context of a communications event to be placed.

Regarding claim 11, Brown discloses a computer data signal embodied in a carrier wave for causing a mobile terminal to perform an incoming/outgoing call history management method for managing an incoming/outgoing call history of the mobile terminal, the computer data signal comprising:

- a detecting source code segment for detecting an incoming or outgoing phone call from or to another mobile terminal; (see col. 2, lines 28-32; col. 4, lines 29-33);

- an acquiring source code segment for acquiring an answering message used in answering an incoming call from a plurality of answering messages in response to the detection of an incoming call; (see abstract, lines 6-9; col. 3, lines 34-39; col. 4, lines 24-54; col. 5, lines 4-21, and Fig. 3);

- a generating source code segment for generating history generation section in which the answering message is kept in association with at least a telephone number of the incoming call as a piece of the history information; a source code for storing the generated history information (see col. 5, lines 21-37; i.e., log of calls with associated caller ID);

- and a notifying source code segment for notifying a user of the mobile terminal of the answering message contained in the piece of the history information (see col. 6, lines 28-33).

Brown doesn't expressly disclose the piece of history information is notified to the user in response to an incoming or outgoing call from or to the telephone number contained in the piece of the history information stored in the history storing section.

However, Maguire teaches a method for viewing communications events history on a mobile device associated with the correspondent of an incoming communications event (i.e., incoming phone call). After a communications event has been received the communications event is added to the database of the mobile device, then upon the receipt of a communications event (i.e., incoming phone call), the mobile device uses the correspondent identification to retrieve and display a communications event history from the database (see abstract; p.0012, lines 1-24; p.0013; p.0027-0028; p.0030-0031; p.0036).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention, to notify the user with history information in response with an incoming call or outgoing call from or to the telephone number contained in the piece of the history information contained in the history storing section, as suggested by Maguire, in order for the user to determine the context of a communications event to be placed.

Regarding claim 13, Brown discloses an integrated circuit for a mobile terminal having a communication function, the integrated circuit comprising circuitry functioning as:

a message storing section operable to store a plurality of answering messages (see abstract, lines 6-9; col. 3, lines 34-39, and Fig. 7; i.e., auto response-messages);

a detection section operable to detect an incoming or outgoing phone call (see col. 2, lines 28-32; col. 4, lines 29-33);

an information acquisition section operable to acquire an answering message used in answering an incoming call from the message storing section in response to detection of an incoming call by the detection section (see col. 4, lines 24-54; col. 5, lines 4-21, and Fig. 3);

a history generation section operable to generate history information in which the answering message acquired by the information acquisition section is kept in association with at least a telephone number of the incoming call as a piece of history information; a history storing section operable to store the history information (see col. 5, lines 21-37; i.e., log of calls with associated caller ID);

and a history notification section operable to notify a user of the mobile terminal of the answering message contained in the piece of the history information (see col. 6, lines 28-33).

Brown doesn't expressly disclose the piece of history information is notified to the user in response to an incoming or outgoing call from or to the telephone number contained in the piece of the history information stored in the history storing section.

However, Maguire teaches a method for viewing communications events history on a mobile device associated with the correspondent of an incoming communications event (i.e., incoming phone call). After a communications event has been received the communications event is added to the database of the mobile device, then upon the receipt of a communications event (i.e., incoming phone call), the mobile device uses the correspondent identification to retrieve and display a communications event history from the database (see abstract; p.0012, lines 1-24; p.0013; p.0027-0028; p.0030-0031; p.0036).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention, to notify the user with history information in response with an incoming call or outgoing call from or to the telephone number contained in the piece of the history information

contained in the history storing section, as suggested by Maguire, in order for the user to determine the context of a communications event to be placed.

9. **Claims 6 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over BROWN et al. in view of MAGUIRE et al., and further in view of MAKELA et al. (US 6,301,338 B1).

Regarding claim 6, the combination of Brown and Maguire disclose the mobile terminal according to claim 1, but doesn't expressly disclose wherein, the message storing section is further operable to store alarm information specifying a time at which to notify with an alarm in connection with the answering message, and the history notification section is operable to notify the user of the answering message associated with the piece of the history information which has reached the time specified by the alarm information.

However, Makela teaches a communication device comprising a message function that sends a reply message in response to an incoming call in a situation where the user can't answer the call him/herself, also time information can be included in the reply message in order to express at which time by the clock or after a how long time the receiving party is reachable (see abstract). In addition, the caller ID data of the received call can be stored automatically and at the same time, the device can store an automatic reminder (i.e., alarm) asking after a certain time the user to call the number in question (see col. 6, lines 10-21).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention, to store alarm information to notify the user with an alarm in connection with the answering message, as suggested by Makela, in order to remind the user of the time that will be available to respond to the missed or unanswered call.

Regarding claim 7, the combination of Brown and Maguire disclose the mobile terminal according to claim 5, but doesn't expressly disclose wherein, the message storing section is further

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operable to store alarm information specifying a time at which to notify with an alarm in connection with the answering message, and the history notification section is operable to notify the user of the answering message associated with the piece of the history information which contains the telephone number that has not yet been redialed and which has reached the time specified by the alarm information.

However, Makela teaches a communication device comprising a message function that sends a reply message in response to an incoming call in a situation where the user can't answer the call him/herself, also time information can be included in the reply message in order to express at which time by the clock or after a how long time the receiving party is reachable (see abstract). In addition, the caller ID data of the received call can be stored automatically and at the same time, the device can store an automatic reminder (i.e., alarm) asking after a certain time the user to call the number in question (see col. 6, lines 10-21).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention, to store alarm information to notify the user with an alarm in connection with the answering message, as suggested by Makela, in order to remind the user of the time that will be available to respond to the missed or unanswered call.

10. **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over BROWN et al. in view of MAGUIRE et al., and further in view of NISHIYAMA et al. (US 6,347,225 B1).

Regarding claim 8, the combination of Brown and Maguire disclose the mobile terminal according to claim 5, but doesn't expressly disclose wherein, if a number of pieces of the history information stored in the history storing section exceeds a predetermined maximum number, the history notification section is operable to automatically delete a piece of the history information

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which contains an already redialed telephone number and which has an oldest time of reception/calling.

However, this feature is well known in the art and Nishiyama is evidence of the fact. Nishiyama teaches a radio telephone system that with a telephone number memory that stores telephone numbers and a response message memory to store response message corresponding to the telephone numbers. In addition it contains a memory for storing telephone numbers that are not responded to with response messages and when is over the storing capacity the oldest telephone number is erased to store the newest telephone number (see abstract; col. 3, line 61 - col. 4, lines 1-3). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention, to automatically delete a piece of the history information which has the oldest time of reception/calling, as suggested by Nishiyama, in order to free up memory to store the newest piece of history.

11. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over BROWN et al. in view of MAGUIRE et al., and further in view of well known prior art (MPEP 2144.03).

Regarding claim 9, the combination of Brown and Maguire disclose the mobile terminal according to claim 5, but doesn't expressly disclose wherein, when a piece of the history information which contains a telephone number that has not yet been redialed is nominated for deletion, the history notification section is operable to present a message to the user to seek approval to delete the piece of the history information.

However, is notoriously well known in the art to present a message to a user to seek approval to delete a piece of information, in order warn the user of the deletion of an important piece of information that the user might want to save.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marisol Figueroa whose telephone number is (571) 272-7840. The examiner can normally be reached on Monday Thru Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like

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assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Marisol Figueroa
Art Unit 2617


LESTER G. KINCAID
SUPERVISORY PRIMARY EXAMINER